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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 10/750,997                | 12/31/2003  | Luke W. Clauson      | 017-002             | 5503             |
| 32746                     | 7590        | 12/07/2006           |                     | EXAMINER         |
| HOEKENDIJK & LYNCH, LLP   |             |                      |                     | HOWELL, DANIEL W |
| P.O. BOX 4787             |             |                      |                     |                  |
| BURLINGAME, CA 94011-4787 |             |                      | ART UNIT            | PAPER NUMBER     |
|                           |             |                      | 3722                |                  |

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/750,997             | CLAUSON, LUKE W.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Daniel W. Howell       | 3722                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 September 2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-60 is/are pending in the application.

4a) Of the above claim(s) 1-6,11,24,36 and 46-60 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 7-10,12-23,25-35 and 37-45 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

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1. The previous examiner has left the PTO. Note the new contact information at the bottom of this Office action.

2. The Office action of 6/15/06 stated that there were two claims 35, and that one of them has been canceled. This is not correct. No claim has been canceled yet. The second original claim 35 and the remaining original claims through number 59 have been renumbered as claims 36-60, respectively. All of the comments below will be directed to the claims as renumbered. When drafting a response, Applicant is reminded that the dependency of the claims will need to be changed to reflect this renumbering.

3. Applicant's election without traverse of Figures 1A-E, 4, and 6, in the reply filed on September 21, 2006, is acknowledged. The previous examiner stated that claims 1-60 were generic, but this is incorrect. Claim 1 states that the cutting element has a threaded region, and only the embodiments figures 7a and 8a have such a feature. Thus, claims 1-6 are not generic, nor do they read on elected figure 1A, such that they will not be examined. Claims 7-10, 12-23, 25-35, 37-45 do read on the embodiment of figure 1A, and they will be examined. Claims 11, 24, 36, and 46 state that the cutting element changes in angular orientation, which is shown in the embodiment figure 2A only, such that these claims and the claims which depend from them will not be examined.

Claims 7-10, 12-23, 25-35, and 37-45 will be examined. Claims 1-6, 11, 24, 36, and 46-60 are withdrawn from consideration.

This restriction requirement is made FINAL.

4. Claims 13-16, 26-29 and 38-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Claim 13 must depend from claim 12, claim 26 must depend from claim 25, and claim 38 must depend from claim 37, in order to provide basis for the first engagement surface. Claim 14 must depend from claim 12, claim 27 must depend from claim 25, and claim 39 must depend from claim 37, as there can't be a second groove without there being a first groove. Claim 29 must depend from claim 25, as there can't be a second engagement surface without there being a first engagement surface. Note that claim 16 must also ultimately depend from claim 12, as there presently is no first engagement surface in the dependency chain.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7-10, 17-23, 30-35, 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Kingman (375,361). Body a has a coaxial screw b with conical head b'. As the screw is rotated and moved axially, the head b' will move cutting elements c, c' radially outward. Note lock screws d.

7. Claims 19-23, 25, 27, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Heule (4756649). Note body 6, 21, rotary actuator 18 having two forward pins/engagement surfaces 13, and blades 3, 4, having grooves/slots 12 for reception of the pins. As the actuator 18 rotates from a first position to a second position, the pins 13 in slots 12 move the cutting blades radially.

8. Claims 32-35, 37, 39, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Young (2278631). Note body 16, two cutting elements 21, actuator 23 which moves axially and has two engagement surfaces 27, and the cutting elements having grooves 28 which receive the engagement surfaces.

9. Claims 7-10, 17-23, 30-35, and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Heldt (2712686). Body 14 has cutters 11 which are moved radially by screw/actuator 26. The screw 26 has a conical surface 32 which cams the cutters radially. Note lock screws 15.

10. Claims 7-10, 12, 14-15, 17-23, 25, 27-28, 30-35, 37, 39-40, 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Leech (1296536). Body 10 has two cutter blades 12 which are moved radially by actuator/screw 17. The screw head/engagement surface fits within a groove 19 of the blades. Note lock screws 14.

11. Claims 7-10, 12-16, 18-23, 25-29, 31-35, 37-41, 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Singer (569303). Singer shows a body A having slots B for cutting blades E and a longitudinally placed screw/actuator D. Each of the cutting blades has a first groove e and a second axially spaced groove e'. The actuator has "swells" or first and second engagement surfaces d', d'', which contact the grooves e, e'. As the screw D is rotated, the blades E are moved radially an equal amount. Claims 13, 26, and 38 state that the engagement surface is "substantially spherical." Looking for a moment at element 22 in Applicant's figure 1B, the "substantially spherical" engagement surfaces 22 are basically annular surfaces having a curved longitudinal profile. If one considers that this surface is "substantially spherical," then it is clear that there's a respectable amount of leeway on what is "substantially

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spherical." Looking at swells d', d", of figure 5 of Singer, it is seen that the only difference between figure 5 of Singer and figure 1B of Applicant's device is that the annular surface of Singer is more elongated than the annular surface of Applicant's device. Considering how much of Applicant's surface 22 in figure 1B is not truly "spherical," it is reasonable to interpret these swells d', d", of Singer as being "substantially spherical."

12. Applicant should note that numerous other references of record could also be applied under 35 USC 102b, and that there are hundreds of references not of record that could have additionally been used against some of the independent claims under 102b. The class definitions of class 408, subclasses 170 and 171 alone could probably be used as the basis for rejection of the independent and some of the dependent claims. While it may be possible to write a claim with allowable subject matter for the species of embodiment 1A-1E, it simply isn't practical for the examiner to cite all of the related references, and Applicant should be aware of the possibility of more references being cited later in the prosecution of this application.

13. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Monica Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.



Daniel W. Howell  
Primary Examiner  
Art Unit 3722